

### **REMARKS/ARGUMENTS**

This Amendment is responsive to the Office Action mailed on April 28, 2010. Applicant has amended claims 2, 26, 28 and 29 to address minor typographical issues. Applicant has also added new dependent claims 35 and 36. Claims 1–12, 25, 26, 28, 29, 31–36 are now pending.

#### ***Allowable Subject Matter***

Claims 1, 4–12, 31, and 34 are allowed. The Office Action also indicated that claims 2 and 3 would be allowable if such claims were rewritten in proper form to overcome the rejections under 35 U.S.C. § 112, second paragraph.

#### ***Claim Rejections – 35 U.S.C. § 112***

Claims 2–3, 26, and 29 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Applicant has amended claims 2, 26 and 29 in the manner suggested in the Office Action, in order to overcome these rejections.

#### ***Claim Rejections – 35 U.S.C. § 101***

Claims 25–26, 28–29, and 32–33 stand rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. Applicant traverses these rejections. Applicant notes that the Office Action failed to address Applicant's previous arguments on these issues, and therefore, some of the arguments below have already been presented to the Patent Office. Claims 25–26, 28–29, and 32–33 (as previously presented) all comply with 35 U.S.C. § 101, as outlined below.

Applicant has added new dependent claims 35 and 36, which each require elements of the respective independent claims to be at least partially implemented via one or more structural components selected from a group consisting of hardware, firmware, one or more processors, one or more application specific integrated circuits (ASICs), and one or more circuit card assemblies. New dependent claims find support from Applicants specification in paragraph [00036]. New dependent claims 35 and 36 address the concerns advanced in the Office Action under 35 U.S.C. § 101, and specifically limit the features to structural components so as to preclude any interpretation that dependent claims 35 and 36 could

cover pure software. Nevertheless, Applicant requests reconsideration of the rejections of independent claims 25 and 28 based on the following discussion.

According to the Office Action, the scope of claims 25–26, 28–29, and 32–33 is directed to software. Also, according to the Office Action, “software is not statutory subject matter.” Applicant disagrees with these assertions and characterizations advanced in the Office Action, and requests that the Patent Office provide justification for the premise that software is not statutory subject matter, to the extent any rejections are maintained. The Examiner has provide not legal justification for the assertion that “software is not statutory subject matter.”

In contrast to the assertions in the Office Action that “software is not statutory subject matter,” Applicant notes that the Supreme Court very recently ruled that software is not excluded under 35 U.S.C. § 101, in the long awaited *Bilski v. Kappos* decision. See *Bilski v. Kappos* 561 U.S. \_\_\_\_ (2010); slip opinion 08–964 (2010). In this case, the Supreme Court of the United States specifically refused to articulate any exclusion for software patentability. On the contrary, the legal question under 35 U.S.C. § 101, as articulated in *Bilski v. Kappos*, is whether the claims cover abstract ideas. In this case, claims 25–26, 28–29, and 32–33 are not directed to abstract ideas, and therefore the claims comply with 35 U.S.C. § 101.

Each of claims 25–26, 28–29, and 32–33 are specifically directed to an “apparatus,” which clearly complies with 35 U.S.C. § 101. The Examiner has not cited any authority that would suggest that any apparatus would ever be non–statutory under 35 U.S.C. § 101, even if the apparatus used software. The Examiner is incorrect, as a matter of law, that software is excluded under 35 U.S.C. § 101. Each of claims 25–26, 28–29, and 32–33 recites specific features of the apparatus that are not abstract ideas. Therefore, claims 25–26, 28–29, and 32–33 are all in compliance with 35 U.S.C. § 101.

Furthermore, claims 25, 26 and 32 are drafted in compliance with 35 U.S.C. § 112, sixth paragraph, rendering such claims statutory per se. To the extent that the Office Action is relying on case law, patent rules, or the MPEP, the language of 35 U.S.C. § 112, sixth paragraph, preempts all of this authority and renders claims 25, 26 and 32 statutory in compliance with 35 U.S.C. § 112, sixth paragraph. The Office Action identified no authority that would render any means plus function claims non–statutory, even if such claims did relate to or cover some aspects of software.

With respect to the means plus function claims, 35 U.S.C. § 112, sixth paragraph, specifically authorizes means plus function terminology and mandates that such a claim: “shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.” Given this clear mandate by Congress and the lack of any authority cited by the Patent Office for the rejections of claims 25, 26 and 32, Applicant is entirely confused as to why the Patent Office has rejected claims 25, 26 and 32 under 35 U.S.C. § 101. The format of claims 25, 26 and 32 (i.e., the means plus function format) renders the claims statutory per se under 35 U.S.C. § 112, sixth paragraph.

In summary, the plain language of 35 U.S.C. § 101 specifically articulates that articles and machines are patentable subject matter. In this case, each of claims 25–26, 28–29, and 32–33 are directed to an apparatus, which is a patentable article or machine. Furthermore, the Supreme Court ruled that software is not excluded under 35 U.S.C. § 101 in the *Bilski v. Kappos* decision. On the contrary, the question under 35 U.S.C. § 101, as articulated in *Bilski v. Kappos*, is whether the claims cover abstract ideas. In this case, claims 25–26, 28–29, and 32–33 are not directed to abstract ideas, and therefore the claims comply with 35 U.S.C. § 101. Finally, claims 25, 26 and 32 are drafted in compliance with 35 U.S.C. § 112, sixth paragraph, thus rendering claims 25, 26 and 32 statutory per se.

In view of these explanations and the claim amendments, Applicant respectfully requests withdrawal of all pending rejections under 35 U.S.C. § 101. If any rejections are maintained, Applicant requests that the Patent Office provide legal authority for the assertions that an apparatus is non-statutory subject matter if the apparatus implements software. Second, if any rejections are maintained, Applicant requests that the Patent Office provide legal authority for the assertions that software is excluded under 35 U.S.C. § 101 (which conflicts with the Supreme Court decision in *Bilski v. Kappos*). Third, if the rejections of claims 25, 26 and 32 are maintained, Applicant requests that the Patent Office provide legal authority for the assertion that means plus function claims are non-statutory if the specification describes software.<sup>1</sup> None of the rejections under 35 U.S.C. § 101 are legally justified. All of the rejections under 35 U.S.C. § 101 must be withdrawn.

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<sup>1</sup> 35 U.S.C. § 112, sixth paragraph, specifically states that the claim limitation “covers the corresponding structure, material, or acts described in the specification and equivalents thereof” (emphasis added). Thus, even if pure software falls outside of “structure material or acts” under 35 U.S.C. § 112, sixth paragraph, (an assertion that Applicant does not necessarily agree with), a claim in means plus function format would not cover such software by virtue of the language of 35 U.S.C. § 112, sixth paragraph. In other words, the

*New Dependent claims*

As mentioned above, Applicant has added new dependent claims 35 and 36 at this time. New dependent claims 35 and 36 depend upon independent claims 25 and 28 respectfully, and each require elements to be at least partially implemented via one or more structural components selected from a group consisting of hardware, firmware, one or more processors, one or more application specific integrated circuits (ASICs), and one or more circuit card assemblies. New dependent claims find support from Applicants specification in paragraph [00036].

New dependent claims 35 and 36 address the concerns advanced in the Office Action under 35 U.S.C. § 101, and specifically limit the features to structural components. Accordingly, new dependent claims 35 and 36 should be allowable even if rejections are maintained on the independent claims. Given the explanations above, however, all pending claims should be allowed without requiring Applicant to incorporate the features of dependent claims 35 and 36 into the respective independent claims.

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question of whether a means for limitation would cover software is a question of statutory interpretation for the courts, and not a question for the Patent Office. Applicant believes that 35 U.S.C. § 112, sixth paragraph, would cover software, or would at least cover software being executed by a processor. However, even if Applicant is wrong on this point, the language of 35 U.S.C. § 112, sixth paragraph, (i.e., the statute) would define the scope of the claim and there would be no justification for rejection of a claim that complies with 35 U.S.C. § 112, sixth paragraph, under 35 U.S.C. § 101 by the Patent Office. In this case, the statute would limit the claim and an interpretation beyond the statute would be improper. On the other hand, if the statute is interpreted as allowing means plus function limitations as covering software, then the rejections would also be unjustified. Accordingly, regardless of whether a means plus function limitation can cover pure software, the rejections under 35 U.S.C. § 101 are unjustified and unnecessary. 35 U.S.C. § 112, sixth paragraph, defines what a means plus function claim can cover, and neither the Patent Office nor Applicant can change the statute to either cover or not cover pure software.

July 15, 2010

***Conclusion***

Applicant respectfully requests reconsideration by the Patent Office and allowance of all pending claims. Please charge any fees or overpayments that may be due with this response to Deposit Account No. 17-0026.

Respectfully submitted,

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